



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/894,659	06/28/2001	Hiroki Moriyama	14731	6961
7590	09/08/2005		EXAMINER	
Paul J. Esatto, Jr. Scully, Scott, Murphy & Presser 400 Garden City Plaza Garden City, NY 11530			JASTRZAB, KRISANNE MARIE	
			ART UNIT	PAPER NUMBER
			1744	

DATE MAILED: 09/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/894,659	MORIYAMA, HIROKI	
	Examiner Krisanne Jastrzab	Art Unit 1744	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 13 June 2005.
 2a) This action is FINAL. 2b) This action is non-final.
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-13 and 16-24 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 5) Claim(s) _____ is/are allowed.
 6) Claim(s) 1-13 and 16-24 is/are rejected.
 7) Claim(s) _____ is/are objected to.
 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>8/2005</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Specification

The incorporation of essential material in the specification by reference to an unpublished U.S. application, foreign application or patent, or to a publication is improper. Applicant is required to amend the disclosure to include the material incorporated by reference, if the material is relied upon to overcome any objection, rejection, or other requirement imposed by the Office. The amendment must be accompanied by a statement executed by the applicant, or a practitioner representing the applicant, stating that the material being inserted is the material previously incorporated by reference and that the amendment contains no new matter. 37 CFR 1.57(f).

Applicant has indicated in the response of 11/15/2004, that the essential material referred to above, is actually present in the original disclosure of the instant application as filed. The Examiner maintains that the specification should then be corrected accordingly to remove the language implying an improper incorporation by reference, for purposes of clarity and completeness. The Examiner would point Applicant to MPEP 608.01 (p) for such authority.

Information Disclosure Statement

The information disclosure statement (IDS) submitted on 8/12/2005 is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

It is noted that the IDS refers to the Japanese "Office action" as providing the statement of relevance for the document submitted, however, no translation of that "Office action" was provided. The Examiner has considered this reference based on the English abstract and the figures.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-5, 9-13 and 17-22 are rejected under 35 U.S.C. 102(b) as being anticipated by Hillebrenner et al., U.S. patent No. 5,534,221.

Hillebrenner et al., set forth a container for endscope sterilization wherein both a tray and lid are provided, with each having a recessed means for predetermined placement and protection of the endoscope with means to prevent different areas of the endoscope to touch during treatment. See column 2, lines 40-45 and 55-62, column 3, lines 1-6, and 10-20 and 29-36, and column 6, lines 10-60, column 7, 64-68, and finally column 10, lines 60-65.

Claims 1-8, 10-13, 16-20 and 22-24 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Mönch U.S. patent No. 4,730,729.

Mönch teaches a container for sterilization of endoscopes and parts therefor having a tray with a recessed section to receive the instrument and a lid for cooperatively covering the tray and instrument. Resilient instrument restraint and protection means are provided in both the tray and lid to protect the instrument during sterilization. An outer lid is also provided above the lid that cooperates with the tray. The container has handles thereon and is constructed for high temperature, high pressure sterilization of endoscopes. See Fig. 4-6, 8 and 11. See also column 2, lines 25-50.

With respect to claim 6, see Fig. 4.

Claims 1-3, 6-8, 10-13, 16-20 and 22 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Hauze U.S. patent No. 4,798,292.

Hauze teaches a container for sterilization of sensitive medical instruments including a tray having resilient means to receive and protectively support an instrument therein. A lid constructed to cooperate with the resilient means of the tray to protectively support the instrument. A second tray/lid is also taught, which is constructed with recesses spaced to accommodate other small parts of the instrument to be sterilized. This lid is further covered with the outer lid. See column 4, lines 25-35, column 7, line 18 through column 8, line 20, and Figs. 9 and 10.

Claims 1-3 and 6-22 are rejected under 35 U.S.C. 102(a) as being anticipated by JP 2000-060791. See Fig. 1.

Terminal Disclaimer

The terminal disclaimer filed on 6/13/2005 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of any patent granted to application serial number 09/919,190 has been reviewed and is accepted. The terminal disclaimer has been recorded.

Response to Arguments

Applicant's arguments filed 6/13/2005 have been fully considered but they are not persuasive. Applicant argues that the Examiner has interpreted the claim limitation of "pressing force preventing means" in a manner inconsistent with the instant specification and claims, however, the Examiner would maintain that she has appropriately interpreted the claim language in its broadest interpretation and all of the references applied meet that limitation with means for preventing shock damage to an endoscope or surgical instrument.

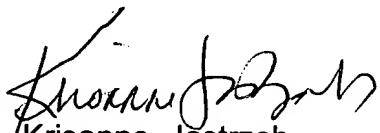
Applicant further argues that the newly added language regarding "one locus portion" more clearly defines the "pressing force preventing means" and that the Hillebrenner fails to meet such means, however, the Examiner would disagree and note that Hillebrenner clearly teaches that the cylindrical support means formed by both the tray and lid, around which the flexible section of the insertion part of the endoscope is placed, has a strength such that it prevents collapse of the container onto the endoscope during pressurized treatment thereof. This clearly meeting the claim language as now presented.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Krisanne Jastrzab whose telephone number is 571-272-1279. The examiner can normally be reached on Mon.-Wed. 6:30am-4:00pm and alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Kim can be reached on 571-272-1142. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Krisanne Jastrzab
Primary Examiner
Art Unit 1744

September 2, 2005